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09/825,718	04/04/2001	Yoji Furuya	36409-01100	3164
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MILBANK, TWEED, HADLEY & MCCLOY 1 CHASE MANHATTAN PLAZA NEW YORK, NY 10005-1413			EXAMINER	
			POND, ROBERT M	
			ART UNIT	PAPER NUMBER
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

## Application No.

09/825,718

## Applicant(s)

FURUYA, YOJI

## Examiner

Robert M. Pond

## Art Unit

3625

**Period for Reply**  
-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 26 December 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 49-52 and 55 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 49-52 and 55 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/C)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_
- Paper No(s)/Mail Date \_\_\_\_\_

## **DETAILED ACTION**

### ***Response to Amendment***

The Applicant amended claims 49-52 and 55. Claims 1-48, 53, 54 and 56 are canceled. All pending claims 49-52 and 55 were examined in this final office action necessitated by amendment.

### ***Response to Arguments***

Applicant's arguments filed 26 December 2007 have been fully considered but they are not persuasive.

- Regarding the argument Debry fails to teach that this certificate authority is arranged to not issue the digital certificate but determine whether such a printer is a printer which can guarantee the safety of the image data, and thus also fails to teach to transmit the image data to the printer based on a determination result.

As noted below in the office action, the certificate authority establishes the printer's credentials and certifies the printer as being trusted or "safe." The remote sever controlling access to user-requested documents obtains the printer's public key from and authenticates the printer as being a safe to receive and print the document.

- Regarding the argument, Debry is silent on how the third party authenticates the printer. In this connection, it should be noted that the printer of the

reference has to obtain in advance the digital certificate from the certificate authority to access the third party.

As noted below, the third party is the remote server controlling access to requested documents.

***Claim Rejections - 35 USC § 103***

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

- 1. Claims 49, 50, 52 and 55 are rejected under 35 USC 103(a) as being unpatentable over Debry (Paper #20070912, US 6,314,521) in view of Stefik (Paper #20061125, US 6,233,684).**

Debry teaches a system and method of printing copyright protected documents to a trusted printer directly without requiring the originating requester to first download the document to the requester's computer or workstation. Debry teaches in any network environment, and specifically the Internet as a preferred network, situations arise where a user desires to print a document that is located remote from the user. The document may be protected from being accessed by anyone other than those users that have access privileges. Typically a user requests the document from the remote system (i.e. a third party), the remote system will verify that the user has the correct access privileges, and if so, then the remote system will send a copy of the document to the user. However, such a user having access privilege may desire to print the document on a remote

printer or print server but does not desire to first retrieve and store the document at the user's own local computer. The file server (of the third-party remote system) may not want a copy of the file to be stored on the client system. The owner of the file (e.g. document) may wish to control the number of copies being distributed to protect copyright and/or payment of fee on a per-copy basis. See at least col. 4, line 45-col. 5, line 8.

Debry further teaches the need to allow a print server (Note: a second party) to receive a print file from the third party identified in the original request (note: the remote system) so that the document can be printed without first obtaining the file by the user workstation originally requesting the system (Note: a first party). According to Debry, the printer needs to have the same access privileges as the user had if the document was accessed protected. See at least col. 5, lines 9-21.

Debry further teaches certificate-based secure communications. For the case where the printer is configured and authenticated by a trusted authority (e.g. certificate authority), the certificate authority server stores the new public key sent to the printer. The public key is then advertised for this printer and is used in all subsequent secure transactions with this printer. See at least col. 6, lines 4-65. For access to resources (note: a document) of a computer system (server) using certificates, the server only needs to authenticate certificates issued by a certificate authority. To gain access to resources of the server, the user (or printer) submits the user's (or printer's) certificate. From the certificate the server

can determine access privileges and authenticate the user (or printer). See at least col. 4, lines 15-39.

Debry further teaches the terms printer, print server, and printing system are used interchangeably. The printer is assumed to have the necessary functional capabilities to perform the required functions whether those functional capabilities are in a stand-alone printer connected to a network (note: Applicants' second printer connection) or a printer connected to a server, i.e., computer, that manages the functions of the printer and device queuing where the server is dedicated solely to such function (i.e. printer server) (note: alternative second printer connection) or as part of its other functions such as a workstation computer (note: Applicants' first printer connection). See at least col. 10, lines 59-67.

Based on the above and supporting teachings of Debry, Debry teaches the following:

- The third party is the remote server controlling access to resources via access privileges.
- The trusted printing device's public key is advertised by the certificate authority for a recipient to use, the recipient being the third party remote server controlling access to content (e.g. document).
- The remotes server uses the printing device's advertised public key and via digital certificates/digital signatures authenticates the printer as a trusted printing device.

Debry further teaches:

- Regarding claim 55. Debry teaches all the above as noted under the 103(a) rejection and teaches i) transmitting document data to a trusted printer at the request of the user and ii) the remote system (i.e. supplier device on the supplier side) managing information to guarantee safety of the data (e.g. printing devices advertised public key, access privileges). Although Debry does not mention image data, Stefik on the other hand teaches text and digital pictures as rendered digital works and further teaches rendering a document at a trusted printer, the document not just limited to text but may include image and graphical data. See at least Fig. 8; col. 1, lines 46-50; col. 10, lines 57-61. One of ordinary skill in the art would have recognized that applying the known technique of Stefik of rendering image data at a trusted printer would have yielded predictable results and resulted in an improved system. It would have been recognized that applying the technique of Stefik to the teachings of Debry would have yielded predictable results because the level of ordinary skill in the art demonstrated by the references applied shows the ability to incorporate such data processing features and methods into similar systems. Obviousness under 35 USC 103 in view of the Supreme Court decision *KSR International Co. v. Teleflex Inc.*
- Regarding claim 55. determining whether a printer that has notified said supplier device of identification information of the printer is a printer that

can guarantee safety of the image data based on the managed information and the notified identification information of said printer. See at least col. 4, lines 15-39. col. 6, lines 4-65.

- Regarding claim 55. and transmitting the image data to said printer, when it is determined that said printer can guarantee the safety of the image data, document sent "on its way" to the printing device once the printing device is authenticated as a trusted device.

wherein said printer comprises:

Debry and Stefik teach and suggest all the above as noted under the 103(a) rejection and further teach and suggest i) a user device (i.e. workstation) with first connection to a printer, the user device requesting a document from a remote server and receiving the document that is printed via the first connection (Debry), ii) a second connection between the printer and the remote server, the user making a request to the remote server to send the document to the trusted printer using the second connection to transmit the document to the trusted printer, the remote server and trusted printer communicating with each other to authenticate the printer (Debry), and further teaches iii) printers may be attached to any or all of the systems (e.g. personal computers, workstations, servers, laptop computers) (Debry). See at least col. 1, lines 35-52; col. 10, lines 59-67. It would have been obvious to try by one of ordinary skill in the art at time the invention was made to incorporate into the system and methods of Debry and Stefik a trusted printer with both a first connection and second connection

whereby the user communicates the print request using the first connection and the printer makes a request to the remote server using the second connection, since there are a finite number of identified, predictable potential solutions to the recognized need (requesting a document to be printed on a trusted printer) and one of ordinary skill in the art could have pursued the known potential solutions with a reasonable expectation of success. Obviousness under 35 USC 103 in view of the Supreme Court decision *KSR International Co. v. Teleflex Inc.*

Debry and Stefik further teach and suggest:

- a first connection unit configured to connect to a user device on a user side; the terms printer and a second connection unit configured to connect to said supplier device via the Internet; based on rationale as noted above.
- a request reception unit configured to connect to said user device by said first connection unit and receive request data from said user device; Inherent in Debry are the structures necessary to configure a request reception unit to connect to the user device. As noted above, the printer has a first connection directly from the user device, the user device being a workstation. See at least Fig. 2 (24-26); col. 10, lines 59-67.
- a notification unit configured to connect to said supplier device via the Internet by said second connection unit and notify said supplier device of the request data and identification information of said printer;

Inherent in Debry are the structures necessary to configure a request reception unit to connect to the supplier device. As noted above, the printer has a second connection to the Internet. See at least Fig. 2 (24-26); col. 10, lines 59-67.

- an image reception unit configured to connect to said supplier device via the Internet by said second connection unit and receive image data corresponding to the request data from said supplier device; document received from remote server is processed by control unit/communication interface and system controller. See at least Fig. 2 (25-27).
- and a printing unit configured to print the image data received, marking engine that prints bit map image onto paper. See at least Fig. 2 (21).
- Regarding claims 50 and 52. Debry teaches all the above as noted under the 103(a) rejection and teaches i) second connection unit for connecting to said supplier device via the Internet, ii) using the Internet for transferring a document to an authenticated printer from a third-party (i.e. supplier of the document) without first having to retrieval and store in a client computer, and iii) owner of the file (i.e. document) wishing to control the number of copies being distributed to protect document copyright and/or payment of a fee on a per-copy basis. Although Debry does not mention and transmitting, to said supplier device, charge information in response to

print by said printing means, Stefik on the other hand teaches problems pertaining to rights protection of printed digital works. Stefik teaches a trusted system and method of rendering digital works by a trusted printer connected to a trusted server over a network (e.g. Internet) and further teaches the trusted printer connected to a user's personal computer (see at least abstract; Fig. 3; col. 3-col. 8). Stefik teaches a loan right may be defined so as to limit the duration of which a work may be loaned. Conditions may also include requirements that fees be paid. Please note: limit duration established a pre-defined time limited (see at least col. 5, lines 55-59). Stefik further teaches the trusted printer repository 302 will in some instances contain an ephemeral copy of a digital work which remains until it is printed out by the print engine 303 (please note: deletion means for deleting image data). In other instances, the printer repository 302 may contain digital works such as fonts, which will remain and be billed based on use (see at least col. 7, lines 29-35). One of ordinary skill in the art would have recognized that applying the known technique of Stefik of transmitting, to said supplier device, charge information in response to print by said printing means would have yielded predictable results and resulted in an improved system. It would have been recognized that applying the technique of Stefik to the teachings of Debry would have yielded predictable results because the level of ordinary skill in the art demonstrated by the references applied shows the ability to

incorporate such data processing features and methods into similar systems. Obviousness under 35 USC 103 in view of the Supreme Court decision *KSR International Co. v. Teleflex Inc.*

**2. Claims 51 is rejected under 35 USC 103(a) as being unpatentable over Debry (US 6,314,521) in view of Stefik (Paper #20061125, US 6,233,684) as applied to claim 49, further in view of Rager (Paper #5, US 5,363,447).**

Debry and Stefik teach all the above as noted under the 103(a) rejection and teach and suggest i) storing charging information in memory, ii) storing print data in an authenticated printer, iii) encrypting print data to make it tamper proof, and iv) deleting information once printed or saving it for repeated use, but do not mention deleting information upon detecting a power-off condition. On the other hand, Rager teaches erasing memory to maintain data security in the event that a device is tampered with or powered down (see at least col. 1, lines 64-67; col. 4, lines 37-49). One of ordinary skill in the art would have recognized that applying the known technique of Rager of erasing memory to maintain data security in the event that a device is tampered with or powered down, would have yielded predictable results and resulted in an improved system. It would have been recognized that applying the technique of Rager to the teachings of Debry and Stefik would have yielded predictable results because the level of ordinary skill in the art demonstrated by the references applied shows the ability to incorporate such data processing features and methods into similar systems.

Obviousness under 35 USC 103 in view of the Supreme Court decision *KSR International Co. v. Teleflex Inc.*

### **Conclusion**

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert M. Pond whose telephone number is 571-272-6760. The examiner can normally be reached on 8:30AM-5:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Jeff Smith can be reached on 571-272-6763. The fax

phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Robert M. Pond/  
Primary Examiner, Art Unit 3625  
March 20, 2008